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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,041	12/11/2003	Lukas Eisermann	MSDI-222/PC765.00	8729
52196 7590 03/24/2008 KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709				
EXAMINER COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
03/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,041

Applicant(s)

EISERMANN ET AL.

Examiner

DAVID COMSTOCK

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008 and 05 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 33-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 33-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 January 2008 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20, 28, 29, 33-42, 44-46 and 48-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuslich (5,059,193).

Kuslich discloses the claimed invention including using in a surgical procedure a body 12 having axial walls 26 interconnected at their ends and an expansion member 16,20 co-acting with the walls to expand the body along a transverse axis (see, e.g., Fig. 1). The body comprises the axial walls that comprise a rectangular cross-section. The expansion member comprises a component of axial displacement along a

Art Unit: 3733

longitudinal axis of the device. The inner surfaces of the walls are arcuate or tapered and accordingly comprise a concave recessed area for receiving the expansion member. The walls deform outwardly to form a convex outer curvature. An inner chamber 116 is accessible via openings between the walls. The chamber is filled with bone growth promoting substance (e.g. bone chips; see col. 8, lines 42-45). The central portion of the body has a width that is greater than that of the ends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuslich (5,059,193).

Kuslich discloses the claimed invention except for explicitly disclosing the bone growth promoting material comprising bone morphogenic protein. However, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided bone growth promoting substance comprising bone morphogenic protein (BMP), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Since BMP is both known in

the art as a bone promoting substance and is suitable for such purpose, it would have been obvious to provide the same for its ordinary purpose of promoting healing.

Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuslich (5,059,193), as applied to claim 1 above, in view of Chauvin (6,371,989).

Kuslich, as modified, discloses the claimed invention except for explicitly reciting the teeth or grooves on the surface of the device. Chauvin et al. disclose a similar device comprising teeth or grooves 11 to provide anchoring in the bone and avoid subsequent migration (see, e.g. col. 5, lines 17-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided device of Kuslich with teeth or grooves, in view of Chauvin, in order to provide anchoring in the bone and avoid subsequent migration. At least some of the teeth would be confined to a central portion of the resulting structure. The grooves have an arcuate configuration.

Response to Arguments

Applicant's arguments filed 07 January 2008 have been fully considered but they are not persuasive.

In response to Applicant's argument, pertaining to the amended claims, that Kuslich allegedly does not show the expansion member engaged with the first and second axial walls at a location intermediate the end portions and extending transversely between and engaging central portions of the axial walls to expand the

body along a transverse axis, it is noted that Examiner's remarks appear to have been misunderstood or misconstrued.

The statement in the previous Office action regarding what Kuslich may not have explicitly or unambiguously shown was not necessarily intended to be a reason for modifying the reference to arrive at the claimed subject matter. In fact, the statement was intended to convey that, *arguendo, even if* the expansion member *were* not located at the claimed location, it *would have been* obvious for a person having ordinary skill in the art to have located the expansion member there. In other words, the expansion member already is at the claimed location and need not be modified; moreover, even if it did need to be modified, even that would have been obvious. However, as already mentioned the expansion member does satisfy the amended claim limitations. Fig. 1 clearly shows that the expansion member contains four diametrically opposed (and transversely extending) expansion member portions (e.g., 20) that are intermediate the end portions and that engage central portions of the axial walls 26 to expand the body along a transverse axis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo

Art Unit: 3733

Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DC/

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733